

REMARKS

Claims 1-23 and 38-59 are pending in the application with entry of this amendment. Claims 1, 14, 38 and 47 are currently amended. The amendments do not present new matter. For example, with reference to Fig. 21, the specification of the subject application explains that “the base member 548a includes a main portion 550, with a groove 552 that is configured to receive the support structure 530a and electrode 526a, and a connector 554 that is configured to removably mate with the slot 520 in the clamp 502.” As shown in Fig. 21, the top or first side of the main portion 550 defines the groove 552, and a relatively thin portion 556 of a connector 54 extends from the bottom, opposite or second side of the main portion 550.

Reconsideration and allowance of the application, as amended, are respectfully requested.

I. Basis of Rejection of Various Claims Not Provided

The Final Office Action does not provide specific remarks or identify specific components of any cited reference to support the rejection of claims 4-8, 13, 22, 39, 42, 45 and 52. Rather, all that is stated with respect to these claims is that these claims are obvious in view of the three cited references. Final Office Action (p. 4). Further, with regard to claims 2, 3 48 and 49, all that is provided is reference to seven different figures of Tetzlaff, but no specific components of Tetzlaff are identified to support the rejection. The Final Office Action provides similar remarks with respect to claims 58 and 59. Final Office Action (p. 5). Again, the Final Office Action merely refers to three references, but does not explain the basis of the rejection or identify any specific component of any reference.

Given the lack of supporting remarks, Applicants cannot determine with specificity which components of which cited references are relied upon to support the rejection. 35 U.S.C. §132 (“Whenever on examination, any claim of a patent is rejected, . . . the Director shall notify the application thereof, stating the reasons for such rejection, . . . together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application . . .”); 37 C.F.R. § 1.194(c)(2) (“In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. . . The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.”).

II. Final Office Action Remarks

Initially, it is stated in the Final Office Action that with regard to paint 27, “we will not read such [operational] characteristics into the claims when they cannot be fairly connected to

the structure recited in the claims.” Final Office Action (p. 9). However, these remarks do not change the fact that claims 1, 14, 38 and 47 as amended recite *inter alia* “a base member having a main portion that includes a first side that defines a groove therein” and “a mating structure extending from the second side and being configured for removably securing the base member to the first clamp member.” Clearly, the claims recite a structural configuration that is differentiated from a layer of paint 27. Further, the line of reasoning relied upon in the Final Office Action does not change the fact that a person of ordinary skill in the art would not consider a layer of paint to be a base member having a mating structure for removably securing the base member to a clamp member. Further, the Examiner has not cited any reference that describes a layer of paint that is used for this purpose, which is understandable since it is well understood that paint is not such a base member.

It is also stated in the Office Action that paint 27 is interpreted as a “base member” and that the paint 27 defines a groove therein for engaging a support member that carries an electrode.” Final Office Action (p. 10). These remarks, however, fail to consider the fact that the claims do not refer to “engaging” as alleged. Rather, the claims recite a mating structure that is configured for removably securing the base member to the first clamp member.” The Final Office Action conveniently utilizes a different term that is not recited in the claim since actually referring to the words of the claims would further undermine the misplaced allegation. In this regard, it is respectfully submitted that the Office Action improperly ignores the structure and the actual language recited in the claims, particularly considering that a person of ordinary skill in the art would not consider paint to be such a base member.

It is also stated in the Final Office Action that the comments regarding a needed “scratch in the coating of paint are at this point irrelevant, as the base member of Francischelli et al. clearly discloses the claimed groove within the base member.” Final Office Action (p. 10). However, this allegation ignores the fact that Applicant’s claims recite a base member having a main portion that includes a first side that defines a groove therein and a second side opposite of the second side, and that the claims also recite *inter alia* “the groove formed within the base member being configured to receive the support member.” Thus, Applicant’s remarks are not “irrelevant” as alleged since they are actually directed to the specific structure recited in the claims (*i.e.*, a groove defined within a first side of the base member). The allegations in the Final Office Action conveniently dismisses this structural configuration and, understandably, do not identify any groove formed or scratched within the paint 27 and do not address the fact that

the claims actually refer to “therein” and “within the base member.”

III. Claims 1-8, 13-18, 22, 38-43, 45, 47-49 and 52-54, 57-59 Are Patentable Over Francischelli in view of Tetzlaff and Hooven

Turning to the claims, independent claims 1, 14, 38 and 47 and respective dependent claims 2-8, 13, 15-18, 22, 39-43, 45, 48, 49 and 52-54 and 57-59 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 6,807,968 to Francischelli *et al.* (“Francischelli”) in view of U.S. Patent No. 6,277,117 to Tetzlaff *et al.* (“Tetzlaff”) and U.S. Patent No. 6,889,694 to Hooven (“Hooven”). Applicants respectfully submit that the amendments to claims 1, 14, 38 and 47 render the misplaced Final Office Action allegations discussed above and in prior amendments and the rejection moot.

First, it is conceded that “Francischelli *et al.* also fail to disclose a stimulation element or means for transmitting stimulation energy carried by the support member and a source of stimulation energy.” Final Office Action (p. 3).

Second, it is conceded that “Francischelli *et al.* fail to disclose the mating structure is configured for removably securing the base member to the first clamp member.” Final Office Action (p. 3).

Third, not only are these concessions correct, but Francischelli also fails to disclose “a base member having a main portion that includes a first side that defines a groove therein and a second side opposite of the first side” and “a mating structure extending from the second side and being configured for removably securing the base member to the first clamp member” as recited in claims 1, 14, 38 and 47.

As discussed above, it is alleged that the coating or paint 27 described by Francischelli is a “base member” as recited in claim 1. Final Office Action (p. 2). It is further alleged that the tube 31A is a “support member” and that the coil 30A is a “coagulation element carried by the support member.” Final Office Action (p. 2).

Thus, following the strained logic of the Final Office Action: 1. the paint 27 (alleged “base member”) must have “a main portion,” 2. this main portion (whatever it might be) of the paint 27 must have first side and a second side opposite of the first side, 3. the first side defines a groove, 4. a mating structure extends from the second side, and 5. this mating structure must be configured for removably securing the base member to the first clamp member. Given these structural requirements, the paint 27 cited in the Final Office Action cannot support the rejection and is, quite simply, not relevant to Applicant’s claims.

Fig. 1A and a top portion of Fig. 2A (which is a cross-sectional view of Fig. 1A along line 2-2, and cited by the Final Office Action) of Francischelli are reproduced below for reference.

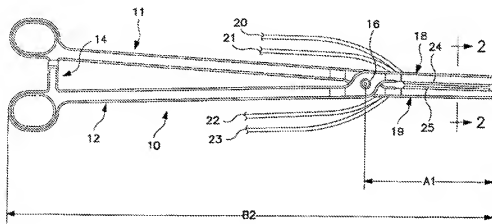
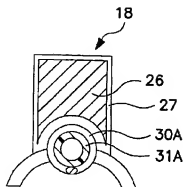


FIG. 2A



As described by Francischelli, the jaw 18 shown in Fig. 1 (a cross-section of which is shown in Fig. 2A) and the jaw 19 are coupled to each other by a pivot or hinge 16 (Fig. 1A). As illustrated in Fig. 1A, the jaw 18 is the top jaw and the jaw 19 is the bottom jaw. The jaw 18 carries a coil 30A and tube 31A such that the electrode 24 and electrode 25 are positioned to contact tissue. Francischelli (col. 1, lines 1-10).

The jaw 18 is made of a metallic core 26 that is coated by paint 27. Francischelli (col. 3, line 66 – col. 4, line 1). As shown in Fig. 2A above, the paint 27 surrounds the metallic core 26. With respect to Fig. 2A, the top portion of the paint 27 layer (*i.e.*, the top portion of the paint 18 adjacent to the arrow extending from the lead line 18) is the top of the jaw 18.

Initially, as is understood, the coating of paint 27 does not include a mating structure.

Further, the paint 27 does not include a mating structure that configured for removably securing the base member to a clamp member.

Francischelli is also deficient since there is no groove defined within the layer of paint 27. The Final Office Action, for some reason, refuses to acknowledge the language in the claims relating to this structure. Moreover, there is no groove formed within the paint 27 that is configured to receive a support member. Rather, as is well understood, paint 27 is simply a thin coating and is not suitable for this purpose. Francischelli cannot be contorted into something it is not.

Additionally, claims 1, 14, 38 and 47 as amended recite *inter alia* “a base member having a main portion that includes a first side that defines a groove therein and a second side opposite of the first side, a mating structure extending from the second side of the main portion and-being configured for removably securing the base member to the first clamp member.” First, it is not clear what portion of the paint 27 would be a “main portion” as recited in these claims. Further, as shown in Fig. 2A of Francischelli above, the layer of paint 27 has no groove therein and, in addition, there is no mating structure extending from a second side of a main portion that is opposite of a first side that defines a groove. The cited layer of paint 27 simply is not related to such a structural configuration. Instead, Francischelli recites a very different structural configuration in which jaws 18, 19 that are coated by paint 27 are coupled at a pivot or hinge 16. See, e.g., Francischelli (Fig. 1A). Thus, not only does the cited reference fail to disclose the structural configuration recited in claims 1, 14, 38 and 47, but such a structure is not necessary since jaws 18, 19 are connected by a hinge 16. Moreover, a mating structure that extends from the top surface of the paint 27 (adjacent to the arrow at the end of lead line 18) would apparently hang out from the top surface of the paint 27 / jaw 18 and serve no purpose since the paint 27 is a coating of the jaw 18, and the jaws 18, 19 are already connected by the hinge 16. Further, given this structure, a person of ordinary skill in the art would not removably secure the paint 27 coated jaw 18 to a clamp member since paint 27 is a coating of the jaw 18 and the jaw 18 is already secured to jaw 19 by a hinge 16.

Tetzlaff and Hooven are also cited in the Final Office Action, but determinative deficiencies of Francischelli discussed above render the rejection moot. Tetzlaff is cited for the limited purpose of allegedly disclosing an insulative base member 121 with a mating structure (122 and 124) that is removably securable to a clamp member. Hooven is cited for the limited purpose of allegedly disclosing a stimulation element. Final Office Action (p. 3). It is also

alleged, without considering or addressing the associated modifications to the cited references, that it would have been obvious to modify the invention of Francischelli et al., as taught by Tetzlaff et al., to provide an insulative base member with a mating structure that is removably securable to the clamp member. Final Office Action (p. 3).

However, the Office Action allegation, as best as can be understood, involves modifying the coating or paint 27 (the alleged “base member”) to: 1. have a mating structure and 2. to carry a stimulation element. As discussed above, the layer of paint 27 is not relevant to claims 1, 14, 38 and 47, particularly in view of the amendments such that these claims as amended recite *inter alia* “a base member having a main portion that includes a first side that defines a groove therein and a second side opposite of the first side, and a mating structure extending from the second side of the main portion and being configured for removably securing the base member to the first clamp member” and “the groove formed within the base member being configured to receive the support member.” Also as discussed above, the paint 27 surrounds the metallic core 26, and the paint 27 and core 26 are parts of a jaw 18.

Following the flawed logic of the Final Office Action in view of the claims as amended, it is apparently alleged that it would be obvious to modify the top surface of the layer paint 27 (adjacent to the arrow of lead line 18 of Fig. 2A above), which is also the top of the jaw 18 (Fig. 1A) since this is the side of the paint 27 that is opposite of the alleged “groove.” However, as is readily understood, this simply does not make sense.

The allegation involves modifying a thin layer of paint 27. Applicant reiterates that paint, quite simply, is paint. As is well understood, paint 27 is not something that is readily reconfigurable as alleged since, as is very well known, paint 27 is thin coating. The Office Action has not reconciled this fact and has naturally failed to explain how paint 27 can be reconfigured as alleged. Paint 27 is not suitable for such modifications, and a person of ordinary skill in the art certainly would not consider, much less consider it obvious, to “modify” the paint or coating 27 as alleged in the Office Action to have a mating structure extending from a top surface (Fig. 2a) of the paint 27 and a stimulation element, particularly considering that the paint 27 coating is presumably so thin that such modifications are not possible or practical, and certainly do not involve a “simple substitution” and do not yield “predictable results.” MPEP 2141, citing *KSR Int'l v. Teleflex*. Further, given these substantial differences, it is not “obvious to try” the modification given the nature of a thin layer of paint 27 and the inherent difficulties of modifying a thin layer of paint 27, which would render such modifications impractical or

impossible. These facts that have not been reconciled by the Final Office Action.

Accordingly, it is respectfully submitted that the Office Action allegations disregard the structure recited in the claims, contort the prior art into something it is not, and rely on allegations that it would be obvious to modify a layer of paint 27 when in fact such a layer of paint 27 is not amenable to such modifications if they are even possible.

Moreover, the general allegations fail to consider the particular structural configuration of the electrodes 24, *i.e.*, they include a coil 30A and tube 31A, and conductive fluid or saline flows “along the length of the electrodes 24 and 25.” Francischelli (col. 3, lines 19-20; Figs. 2A-B). Making substantial modifications to Francischelli as alleged, if they are even possible given the nature of a thin layer of paint 27, would presumably result in altering the electrode 24 configuration. The Office Action, however, does not consider and does not address how the fluid chamber remains operable to allow conductive fluid to flow along the length of the electrodes through an inner lumen of an electrode.

Additionally, given the particular structural configuration of the paint 27 (the alleged “base member”), Francischelli teaches away from “a base member having a main portion that includes a first side that defines a groove therein and a second side opposite of the first side, and a mating structure extending from the second side of the main portion and-being configured for removably securing the base member to the first clamp member” and “a support member, the groove formed within the base member being configured to receive the support member” as recited in Applicant’s claims since the coating of paint 27 is not amenable to this structural configuration unless, *e.g.*, the paint is scratched to define some type of groove, but this is not disclosed by Francischelli and certainly would not be feasible since any scratch formed within the paint 27 would be so small such that any groove that is formed would not be of sufficient size to receive a base member as recited in the claims. For similar reasons, Francischelli teaches away from the substantial configurations alleged in the Office Action since it would be very difficult, if not impossible, to reconfigure a coating of paint 27 as alleged in the Office Action. In this regard, the Office Action has not explained how this would be possible.

Francischelli also explains that the jaws 18 and 19 “are made of a metallic core 26, 28” (Francischelli (col. 3, lines 66-67)), but the Office Action does not explain how molded plastic snap-fit components as described by Tetzlaff would be integrated into or used with metallic core components 26, 28 and paint 27 coatings, particularly considering that Applicant’s claims as amended recite *inter alia* “a base member having a main portion that includes a first side that

defines a groove therein and a second side opposite of the first side, and a mating structure extending from the second side of the main portion and-being configured for removably securing the base member to the first clamp member.”

In view of these substantial deficiencies and determinative structural differences, Applicants respectfully submit that independent claims 1, 14, 38 and 47 are patentable over the three cited references. Dependent claims 2-8, 13, 15-18, 22, 39-43, 45, 48, 49 and 52 incorporate the elements of respective independent claims 1, 14, 38 and 47 and, therefore, are also believed patentable over the cited references.

Further, as discussed in Section II, the Final Office Action does not provide any specific remarks to support the rejection of claims 4-8, 13, 22, 39, 42, 45 and 52. Rather, all that is stated is that these claims are obvious in view of the three cited references. Final Office Action (p. 4). With regard to claims 2, 3 48 and 49, all that is provided is reference to seven different figures of Tetzlaff. No specific components of any cited reference are identified to support the rejection. Further, the Office Action provides similar remarks with respect to claims 58 and 59.

However, with respect to claim 58 and Francischelli, for example, claim 58 recites *inter alia* “wherein the base member is formed of a non-metallic material.” The deficiencies with respect to paint 27 being a “base member” having a first side that defines a groove therein and a second, opposite side from which a mating structure extends are discussed in detail above. Applicants further note that the cores 26, 27 are metallic. Francischelli (col. 3, line 67).

With respect to claim 59 and Francischelli, for example, claim 59 recites *inter alia* “wherein segments of the base member extend around a top portion of the support member to hold the support member within the groove.” In contrast, the structure shown in Fig. 2A of Francischelli clearly lacks this structure.

Applicants respectfully request that the rejection of claims 1-8, 13-18, 2, 38-43, 45, 47-49 and 52 under §103(a) be withdrawn.

IV. Claims 10, 11, 20, 50 and 51 are Patentable Over Francischelli in view of Tetzlaff and Hooven and What is Known in the Art

Dependent claims 10, 11, 20, 50 and 51 incorporate the elements and limitations of respective independent claims 1, 14 and 47 and, therefore, are also believed patentable over the three cited references and what is known in the art.

V. Claim 55 is Patentable Over Francischelli in view of Tetzlaff, Hooven and Eggers

Dependent claim 55 incorporates the elements independent claim 1 and, therefore, is also believed patentable over the cited references since U.S. Patent No. 6,032,674 to Eggers does not cure the deficiencies discussed above.

VI. Claim 56 is Patentable Over Francischelli in view of Tetzlaff, Hooven and Fogarty

Dependent claim 56 incorporates the elements independent claim 1 and, therefore, is also believed patentable over the cited references since U.S. Patent No. 6,558,408 to Fogarty does not cure the deficiencies discussed above.

CONCLUSION

In view of the foregoing claim amendments and remarks, Applicants respectfully submit that the application is in condition for allowance. If there are any remaining issues that can be resolved by telephone, Applicants invite the Examiner to kindly contact the undersigned at the number indicated below.

Respectfully submitted,

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